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In re application of Geert Maertens et al.	:	
Serial No. : 09/638,693	:	DECISION ON PETITION
Filed : August 15, 2000	:	
Attorney Docket No.: 2752-15	:	

This is in response to applicants' petition, filed December 11, 2003 under 37 CFR 1.181, to withdraw the restriction requirement set forth by the examiner. This petition is being treated as a petition under 37 CFR 1.144.

BACKGROUND

Review of the file history shows that the application was filed August 15, 2000 under 35 U.S.C. 111(a) as a continuation of 08/362,455 which was filed January 11, 1995 under 35 U.S.C. 371 as the National Stage of PCT/EP94/01323, filed April 27, 1994, which claims priority to European patent applications 93.402019.9 and 93.401099.2, filed August 5, 1993 and April 27, 1993, respectively. The application as filed contained 23 claims. After several preliminary amendments, claims 56-85 were pending. On March 24, 2003 the examiner mailed a restriction requirement which required applicants to elect a single polypeptide sequence and methods of use for examination. On June 24, 2003 applicants filed a response in which they elected SEQ ID No. 36. Applicants traversed the restriction requirement on essentially the same grounds presented in the instant petition. On September 11, 2003 the examiner mailed a first Office action on the merits, in which the restriction requirement was made final.

DISCUSSION

Applicants present several lines of argument in the petition. First, applicants argue that the subject matter of the pending claims was grouped together in a lack of unity determination in the "parent" international application. This argument is not persuasive. First, applicants and examiner are reminded that the instant application is not the national stage of the cited international application, but rather a continuation of the national stage application. As an application filed under 35 U.S.C. 111(a), the application is not subject to unity of invention practice. As MPEP 1896, section IV states:

> U.S. national applications filed under 35 U.S.C. 111(a) are subject to restriction practice in accordance with 37 CFR 1.141-1.146. See MPEP § 803. U.S. national stage applications **>(which entered the national stage from international applications after compliance with 35 U.S.C. 371)< are subject to unity of invention practice in accordance with 37 CFR 1.475 and 1.499 (effective May 1, 1993).

Even if the application were subject to lack of unity practice, applicants' argument would not be persuasive. The international application was searched in the European Patent Office (EPO). Decisions made in the EPO are not binding on USPTO examiners. Moreover, since applicants did not pay additional fees to have the instantly claimed invention searched, providing a copy of the international search report does nothing to aid in the examination of the pending claims.

Applicants argue that the examiner's assertion that the claims encompass many unrelated polypeptides is unsubstantiated. This assertion is substantiated by the claims themselves, which are clearly drawn to a great number of different polypeptides, each of which would require a separate search. Absent any evidence or explanation to the contrary, this line of argument is not persuasive.

Applicants argue that the all the claimed polypeptides share a special technical feature because they are derived from the same virus. This argument is not persuasive because lack of unity practice does not apply to this application. Moreover, the claimed polypeptides would not have unity of invention in any event. PCT Administrative Instructions, Annex B, part I(f)(i) states:

> (i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:
> (A) all alternatives have a common property or activity, and
> (B) (1) a common structure is present, i.e., a significant structural element is shared by all the alternatives, or
> (B) (2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The claimed polypeptides do not meet these criteria.

Applicants argue that the prior art cited by the examiner is not applicable to the claims. This argument is not persuasive because the propriety of a restriction requirement is not predicated on the availability of applicable prior art.

Applicants complain that there have been delays in the prosecution of this application. This argument is not persuasive because each application is examined on its merits, without regard for delays that may occur during prosecution. There is no provision in statute or regulation for according special treatment to applications subject to clerical

errors or other sources of delay. Any further requests for relief on this ground should be in the form of a petition to the Commissioner under 37 CFR 1.182.

Finally, applicants argue that "the subject matter of the present claims has, in many respects, been previously examined and indicated as allowable over the art of record, by the present Examiner." This argument is incorrect and therefore not persuasive. The claims of the parent application are drawn to nucleic acid sequences, while the claims of the instant application are drawn to polypeptides. Furthermore, the claims of the parent application used closed claim language, so that only nucleic acids *consisting of* 8 or more contiguous nucleotides of specific sequences are included within the metes and bounds of the claims. The claims in the instant applications are drawn to any polypeptide *comprising* 5 or more contiguous amino acids from the recited sequences, so that unrelated polypeptides having as few as 5 amino acids in common with the recited sequences are included within the metes and bounds of the claims. Moreover, due to the degeneracy of the genetic code, the nucleic acids encoding two polypeptide sequences having 5 contiguous amino acid residues in common need not have 8 contiguous nucleotides in common. The claims in the two applications are clearly not equivalent and the subject matter of the claims pending in the instant application has clearly not been searched previously by this examiner.

DECISION

Applicants' petition is **DENIED**.

The application will be forwarded to the examiner for consideration of the response filed December 11, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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